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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,270	12/20/2000	Michael Gargiulo	NC25580	2797

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STEVEN A. SHAW  
NOKIA, INC.  
6000 CONNECTION DRIVE  
MD 1-4-755  
IRVING, TX 75039

EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/746,270

Applicant(s)

GARGIULO ET AL.

Examiner

Nabil M. El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claims 1-10 are pending in this application. Claims 7-10 have been cancelled. Claims 1-6 are presented for examination.

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

3. The disclosure is objected to because of the following informalities: The disclosure refers in page 3 (and may be in other locations) to Appendix A, which does not exist. The reference to Appendix A is not deleted as indicated in the remarks filed by the applicant. Appropriate correction is required.

4. The disclosure is objected to because it contains, in almost all the Pages, an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Not all references to hyperlink and/or other form of browser-executable code are deleted as indicated in the remarks filed by the applicant (for example, p 22, line 27, p 25, line 14, etc). Appropriate correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following words or phrase are not clearly understood rendering the claims vague or indefinite:

a) "saving the media in a temporary memory of a mobile station", and "previewing the media on the mobile station", claim 1, lines 7-8. First, it is unclear if the media content is send originally to the mobile station, to any other entities, or even the accounting is performed for the mobile station, see the preamble. Second, it is unclear if the media content is requested by the mobile station or any other entities, see line 3. Thirdly, it is unclear if a first identification number has anything to do with the mobile station, is it identifying a request number, a transaction number, an IP address, a mobile station ID, etc., see lines 3-4. Forth, it is unclear if the mobile station itself is receiving a message with the media content, see line 5. Fifth, it is unclear if the primitive using the URL is send by the mobile station, see lines 9-10. Finally, it is unclear if the permanent memory used to save the media content is in the mobile station, see line 11.

b) "previewing the media on the mobile station", claim 1, line 8, it is unclear what previewing the media exactly means. First, "the media" is probably is referring to "the media content". Second, it is unclear if the whole media content is being previewed or part of the media content is being reviewed. "Previewing" is conventionally used to show "parts of" or "clips of"

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the content but not the whole content, specially if a temporary memory, which may not have enough capacity, is being used to save the content.

c) "the identification information", claim 1, line 9, it is unclear if "the identification information" is related to the mobile station, and specifically when it has no antecedent basis in the claim.

d) "the device may preview the media", and "may be saved", claim 2, lines 9-10, claim 3, lines 11-12, claim 4, lines 9-10, and claim 5, lines 10-11. The word "may" renders the claim indefinite because it is unclear whether the limitation(s) following the word is part of the claimed invention. See MPEP § 2173.05(d).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable Dusse et al. (US 6,647,260), hereinafter "Dusse".

9. As to claim 1, Dusse discloses the invention substantially as claimed including a method for accounting for media content sent over a communication system (col. 6, lines 55-57), the

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method comprising: requesting media content by sending message with a header comprising a first identification number (provisioning request, and device identification information, col. 5, lines 6-10,15-16); receiving a message which comprises the media content, a reply Universal Resource Locator (URL) identifying a server, and a transaction identification (col. 5, lines 23-30); saving the media in a temporary memory of a mobile station ( col. 8, lines 34-40); previewing the media on the mobile station (terms and conditions are pushed to the mobile station and accepted, i.e previewed, col. 8, lines 35-47); sending a primitive with the identification information to the server identified by the URL ( col. 6, lines 55-58); and saving the media in a permanent memory only when permission to save has been received ( col. 7, lines 32-40).

10. Dusse discloses the provisioning server contacting a server for the billing service, but does not explicitly disclose including a reply URL identifying the server and a transaction identification. However, it would have been obvious to one skilled in the art at the time of the invention that such contact would include the URL for the billing service and as well as transaction identification in order to facilitate billing charges for the accounting purposes

11. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al. (US 5,909,492), hereafter, Payne.

12. As to claim 2, Payne discloses the invention substantially as claimed including a method in a server (merchant computer 14, Fig. 1) coupled to a network, the method of accounting for media content comprising: providing a device on the network (buyer computer 12, Fig. 1) with a

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plurality of media choices (buyer computer 12, Fig. 1 is provided with media choices in the form of advertising documents for variety of products, col. 5, lines 26-27; in the form of chopping cart content, col. 8, lines 24-25; a smart statement with different items, col. 8, lines 32-36; a transaction detail with different items, col. 9, lines 3-7; products included in the smart statement is displayed, col. 9, lines 40-41); receiving a selection from the plurality of media choices from the device (col. 5, lines 26-27, 48-49); generating a database record, a transaction number, and an URL (col. 5, lines 49-55; and col. 5, lines 29-43); sending a message to the device, said message comprising the URL and the media content (col. 5, lines 49-56), wherein the device may preview the media (e.g. the contents of the shopping cart is previewed, col. 8, lines 24-25; a smart statement is previewed, col. 8, lines 32-36; a transaction detail is previewed, col. 9, lines 3-7; and a product included in the smart statement is previewed, col. 9, lines 40-41) and is required to send a primitive to the URL (e.g. payment URL, col. 5, lines 53-62) before the media content may be saved to a permanent memory of the device ( the media content may be saved in a permanent memory of the buyer computer).

13. Payne does not necessarily disclose saving the media content in a permanent memory of the device. However, it would have been obvious to one skilled in the art at the time of the invention to consider Payne's disclosure of a shopping cart as storing the selected media content (products) until it is actually purchased after approval from the payment computer, and permanently storing the contents of the shopping cart; the smart statement , the transaction detail, and/or; products details included in the smart statement.

14. As to claim 3, the claim is rejected for the same reasons as claim 2 above. In addition, a computer-readable memory for directing a computer to function in a particular manner when

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used by the computer, comprising: a first portion to direct the computer to provide a device with a plurality of media choices; a second portion to direct computer to receive a selection from the plurality of media choices from the device; a third portion to direct computer to generate a database record; a fourth portion to direct computer to generate a transaction number; a fifth portion to direct computer to generate an URL; and a sixth portion to direct a computer to send message comprising the URL and the media to the device, wherein the device may preview the media and is required to send a primitive to the URL before the media content may be saved to the permanent memory of the device is clearly inherent in Payne's disclosure.

15. As to claim 4, the claim is rejected for the same reasons as claims 2 and 3 above. In addition, a computer data signal embodied in a carrier wave, comprising instructions for: providing a device on the network with a plurality of media choices; receiving a selection from the plurality of media choices from the device; generating a database record; generating a transaction number; generating an URL; sending a message to the device, said message comprising the URL and the media content, wherein the device may preview the media and is required to send a primitive to the URL before the media content may be saved to -the permanent memory of the device is clearly inherent in Payne's disclosure.

16. As to claim 5, the claim is rejected for the same reasons as claims 2-4 above. In addition, a computer program product fixed on a tangible medium that enables a network entity to account for media content comprising: computer readable code that instructs computer to: provide a device on with a plurality of media choices; receive a selection from the plurality of media choices from the device; generate a database record; generate a transaction number; generate an URL; and send message comprising the URL and the media to the device, wherein



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the device may preview the media and is required to send a primitive to the URL before the media content may be saved to the permanent memory of the device; and a tangible medium that stores the computer readable code is clearly inherent in Payne's disclosure.

17. As to claim 6, Payne does not explicitly disclose the computer product fixed on a tangible medium selected from a group of hard-disc, CD-ROM, DVD, floppy disc, and flash memory. However, It would have been obvious to one skilled in the art at the time of the invention to consider Payne's disclosure of a computer program product for accounting of media content system to be fixed on a tangible medium that may take any of the suitable forms that work with a network device such a hard-disc, CD-ROM, DVD, floppy disc, or flash memory as long as it will accessible to a processor to execute it.

18. Applicant's arguments filed 4/1/2005 have been fully considered but they are not persuasive. Therefore the rejection of claims 1-6 is maintained.

19. In the remarks, applicants argued in substance that Payne et al does not teach that a purchaser can preview media before paying and saving the media in a permanent memory.

20. Examiner respectfully traverses applicants' remarks.

21. Applicant is referred to the rejection of the claims above which asserts that Payne et al does teach that a purchaser can preview media before paying and saving the media in a permanent memory.

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22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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June 14, 2005

A handwritten signature in black ink, appearing to read "N. El-Hady". The signature is stylized with a large, sweeping "N" and a cursive "El-Hady".

Nabil El-Hady, Ph.D, M.B.A.  
Primary Patent Examiner  
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